88-1356 (1)

No. _____

Supreme Court, U.S.
FILED
FEB 14 1989
JOSEPH F. SPANIOL, JR.
CLERK

IN THE

SUPREME COURT OF THE UNITED STATES

TERM 1988 - 1989

JAMES N. CONSTANT,

Petitioner

v.

ADVANCED MICRO-DEVICES, INC., et al.,

Respondents *

PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

James Constant
1603 Danbury Drive
Claremont, CA 91711
(714) 624-1801

Pro se petitioner

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* see APPENDIX A for a complete list of all Respondents

QUESTIONS PRESENTED FOR REVIEW

1. Does the district court have jurisdiction to perform the Patent Office function under 35 USC 302 et seq. for the reexamination of petitioner's patents, based on references not considered by the Patent Office (distinct from references considered by the Patent Office).

2. Whether the reexamination of patents by a district court, based on references not considered by the Patent Office, is an administrative or executive act.

3. Should a party pay the high cost of a formal court trial when it informs the court that Congress by statute provides for a low cost procedure to resolve the matter.

4. Should a party pay the high cost of a special master to review technology when it informs the court that the special master admits not having qualifications in any technology.

5. Should a party pay the high cost of a special master when it informs the court before trial of its inability to pay the master's fees.

6. Whether a patent lawyer who admits lacking qualifications in any technology and who admits that he is not qualified to testify as a technical expert can be appointed as a special master expert and used to write technical reports and to give technical testimony to defeat a United States patent.

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PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

The petitioner, James Constant, respectfully prays that a writ of certiorari issue to review the decision of the United States Court of Appeals for the Federal Circuit decided 11 October, 1988 attached as APPENDIX A.

OPINION BELOW

The Court of Appeals for the Federal Circuit issued its decision affirming the "Order Granting Defendant's Motion to Retax Costs and Denying Plaintiff's Motion to Dismiss and Disallow Costs and for Sanctions" of the United States District Court for the Central District of California attached as APPENDIX B.

JURISDICTION

The jurisdiction of this Court is invoked under 28 USC 1254(1).

STATEMENT OF THE CASE

Petitioner's two patents were found invalid by the district court on the basis of recommendations by a special master over petitioner's objections that the court lacked jurisdiction to perform the Patent Office function under 35 USC 302 et seq., that the special master was not technically qualified, and that petitioner was unable to assume payments for the master's fees. The court of appeals affirmed. Constant v. Advanced Micro-Devices, Inc. 7 USPQ2d 1057 (Fed. Cir. 1988).

Costs of the patent litigation were taxed against petitioner in the amount of $123,832 (App. B). The court of appeals affirmed the decision (App. A-1 through A-7) and denied petitioner's Petition for Rehearing (App. A-8) and Suggestion for Rehearing in Banc (App. A-9).

REASONS FOR GRANTING THE WRIT

Costs against the petitioner ($123,832) were taxed in abuse of discretion in view of the court's lack of jurisdiction to re-examine petitioner's patents on the basis of references not considered by the Patent Office, in view of the low cost procedure for the reexamination of patents in the Patent Office under 35 USC 302 et seq. ($1,770 for each patent), in view of the special master's admitted lack of qualifications in any technology (the master's fee amounts to $85,598 of the total), and in view of appellant's inability to pay the master's fee. The district court was informed about these matters before it appointed the special master to review the two patents in suit.

1. While the district court has the power to review the Patent Office acts of granting petitioner's patents based on the record and to review the reexamination of petitioner's patents under 35 USC 302 et seq., based on references that were considered by the Patent Office, it lacks the power to perform the Patent Office function under 35 USC 302 et seq. for the reexamination of petitioner's patents based on references not considered by the Patent Office. The decision therefore to invalidate petitioner's patents, based on references not considered by the Patent Office, is an administrative act not a judicial act. In the absence of a record in the Patent Office for references used by the district court to invalidate petitioner's patents, there is a clear absence of all jurisdiction to reexamine petitioner's patents.

In affirming the district court's decision to invalidate petitioner's patents, the court of appeals ruled that

"There is no legal authority for the view that the court must first determine that the prior art in the evaluation of obviousness is more pertinent than the prior art considered by the PTO". Constant, supra 1065

However, this opinion contravenes the purpose for enactment by Congress of 35 USC 302 et seq. which provides for a determination of issue. 35 USC 303.

The district court's taxing of costs against petitioner in light of its lack of jurisdiction to perform the Patent Office function under 35 USC 302 et seq. for the reexamination of petitioner's patents, on the basis of references not considered by the Patent Office, is an abuse of discretion.

2. The responsibility for the reexamination of patents based on new art has been committed by Congress to the Patent Office. 35 USC 302 et seq. A court only performs an administrative or executive act when it determines the validity of a patent based on references not consiby the Patent Office in granting petitioner's patents. Jurisdiction should not be granted for such exercising of discretion to perform the administrative or executive function of the Patent Office.

3. Petitioner recommended the low cost Patent Office procedure under 35 USC 302 et seq. to the district court and the respondednts opposed. See transcript for the hearing on 5 May, 1986 at page 9 line 9 through page 11 line 8 and page 13 lines 14-23; transcript appears as Exhibit B in petitioner's Motion to Dismiss Determination of Costs filed 1 April, 1988 (RDN 726) (RDN = Relevant Docket Number).

The district court's taxing of costs against petitioner in light of its knowledge of the low cost procedure in the Patent Office for the reexamination of patents amounts to an abuse of discretion.

4. The special master (R. Hillman), appointed by the district court over petitioner's objections, admitted that he was not qualified in any technology. See Exhibits in petitioner's Petition for Rehearing and Suggestion for Rehearing in Banc (hereinafter EXHIBITS). As shown in EXHIBITS, Hillman admits "I do not have expert qualifications in this or any other technology" and "I would not be qualified to testify as a technology expert". Yet Hillman did just that and Judge Wilson used Hillman's technical reports and testimony to invalidate petitioner's patents and to retax the master's fees against petitioner (app. B). At trial, the district court refused to allow petitioner's questions directed to the master's qualifications (RDN 693 4-30) and directed that the master's testimony be limited to

the technical questions. See transcript for hearing 30 March, 1987 p 9 lines 21-24.

The court of appeal's finding that "Hillman is very well qualified", Constant, supra 1061, is not supported by the evidence in EXHIBITS. Moreover, Hillman does not qualify as a technical expert under the Federal Rule of evidence 702 or under the case authorities. See Forbro Design Corp. v. Raytheon Co., 190 USPQ 49 (CA 1 1976) (a person lacking qualifications in the pertinent art for testifying what would or would not have been known to one of ordinary skill in the pertinent art, should not be allowed to express an opinion); Nyyssonen v. Bendix Corp., 342 F2d 531, 144 USPQ 555 (CA 1 1965)(citing B.F. Sturtevant Co. v. Massachussets Hair & Felt Co., 122 F2d 900, 51 USPQ 198, CA 1 1941, cert. den. 315 US 823, 52 USPQ 644, 1942)(A patent speaks to its art and what it says can be told in

complicated cases only by one skilled in the art).

The district court's taxing of costs against petitioner in light of its knowledge that the special master was not qualified in any technology amounts to an abuse of discretion.

5. Petitioner informed the district court that appointment of the special master would create financial hardship on him (one reason Congress enacted 35 USC 302 et seq.). See petitioner's Opposition to Defendant's Motion to Retax Costs filed 6 April, 1988 paragraphs 3-11 and Exhibits E,F,G,I (RDN 730); see petitioner's financial statement filed 15 July, 1986 (RDN 605).

The district court's taxing of costs against petitioner in light of its knowledge that petitioner was unable to pay the master's fee amounts to an abuse of discretion.

The Federal Circuit finding that "There is no legal authority for the view that the court must first determine that the prior art in the evaluation of obviousness is more pertinent than the prior art considered by the PTO", Constant, supra 1065, contravenes the purpose of 35 USC 302 et seq.

The Federal Circuit finding that "Hillman is very well qualified", Constant, supra is inopposite to the evidence in EXHIBITS, to Federal Rule of Evidence 702, and to the case authorities in Forbro, Nyyssonen, and Sturtevant, supra.

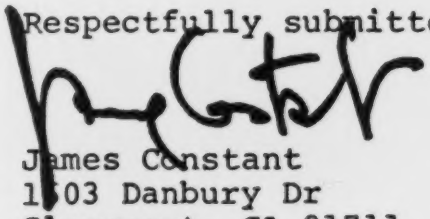
The petition should be granted because the court of appeals has so far sanctioned a departure from the usual course of judicial proceedings as to call for an exercise of this Court's power of supervision.

CONCLUSION

Because the district court lacks jurisdiction to perform the Patent Office function under 35 USC 302 et seq., for the reexamination of patents, based on references not considered by the Patent Office, because petitioner informed the court that the low cost procedure under 35 USC 302 et seq. was available to resolve matters, because the special master was not qualified in any technology, and because petitioner informed the court that he was unable to pay the master's fees, the costs against petitioner were taxed in abuse of discretion.

For the foregoing reasons, petitioner James Constant respectfully requests that a writ of certiorari issue to review the decision of the United States Court of Appeals for the Federal Circuit attached as APPENDIX A.

Respectfully submitted



James Constant
1503 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner

14 February, 1989

A P P E N D I X A

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1414

JAMES CONSTANT,

Plaintiff-Appellant,

v.

ADVANCED MICRO-DEVICES, INC.; GOULD, INC.; AMERICAN MICROSYSTEMS, INC.; ANALOG DEVICES, INC.; FUJITSU, LTD.; FUJITSU MICROELECTRONICS, INC.; DIGITAL SWITCH,INC.; GRANGER ASSOCIATES, INC.; HITACHI CORPORATION; INTEL, INC.; INTERACTIVE CIRCUITS & SYS LTD.; MATSUSHITA ELECTRONICS CORP.; COMPUTER MODULES, INC.; NIPPON ELECTRIC CO., LTD.; NEC ELECTRONICS USA; PARADYNE CORPORATION; SEMICONDUCTOR PRODUCTS; TEXAS INSTRUMENTS, INC.; and TRW, Inc.,

Defendants-Appellees.

DECIDED: October 11, 1988

Before SMITH, NIES, and NEWMAN, Circuit Judges. SMITH, Circuit Judge.

DECISION

James Constant (Constant) appeals the "Order Granting Defendant's Motion to Retax Costs and Denying Plaintiff's Motion to Dismiss and Disallow Costs and for Sanctions" of the United States District Court for the Central District of California in Constant v. Advanced Micro-Devices, Inc., No. 85-0262-SVW (C.D. Cal. filed May 10, 1988). We affirm.

OPINION

Constant mounts a 12-point attack on the district court's order. These 12 points, however, only provide us with 3 main issues: (1) whether the district court abused its discretion in refusing to recuse itself from presiding over the parties' motions; (2) whether the constitution prohibits a federal court from adjudicating the validity of a patent; and (3) whether the district court abused its discretion in its taxation of costs against Constant.

A. Failure to Recuse Was Not an Abuse of Discretion.

Constant urges to us that, because Judge Wilson was named by Constant as a defendant in a fraud suit relating to this case, Judge Wilson abused his discretion by not recusing himself from presiding over this proceeding. Constant, citing United States v. Sibla, 624 F2d 864 (9th Cir. 1980), contends that judges have a duty to recuse themselves if they become aware of grounds for recusal. We have no argument with the rule contended for; however, the record facts do not give rise to such a duty.

Under the law of the United States Court of Appeals for the Ninth Circuit, the law that controls our review of this issue, see Panduit Corp. v. All States Plastic Mfg. Co., 744 F2d 1564, 1575, 223 USPQ 465, 471 (Fed. Cir. 1984),

a judge need not recuse himself merely because a litigant sues or threatens to sue him. See United States v. Studley, 783 F2d 934, 940 (9th Cir. 1986); Ronwin v. State Bar of Arizona, 686 F2d 692, 701 (9th Cir. 1981). Here, as determined by Judge Wilson, the existence of the fraud suit did not provide grounds for recusal. Indeed, as subsequent events proved, the whole fraud proceeding, on appeal, was deemed frivolous. See Constant v. Wilson, No. 88-1195 (Fed. Cir. Aug. 25, 1988).

B. A District Court Is Not Constitutionally Precluded from Adjudicating the Validity of a Patent.

Constant contends both that the Constitution may prohibit a district court from performing the "Patent Office function under 35 USC 302 et seq. (distinct from reviewing acts of the Patent Office) and

that 35 USC 282 is unconstitutional. These contentions are a reworded version of the argument Constant presented to us in Constant v. Advanced Micro-Devices, Inc., 848 F2d 1560, 7 USPQ2d 1057 (Fed. Cir. 1988), that the Constitution prohibits a district court from adjudicating the validity of a patent. Because this argument already has been rejected by this court, id at 1563-65, 7 USPQ2d at 1058-60, we do not address it here.

C. The District Court Did Not Abuse Its Discretion in Awarding Costs.

With respect to the specific costs awarded by the district court to the appellees, Constant relies on the same arguments he made to the district court in response to appellee's motions for costs. The court below rejected these arguments and we cannot hold that it was an abuse of discretion to do so.

The appellees were the prevailing party in the patent infringement action brought by Constant and, as such, were entitled to costs, pursuant to the local rules of the district court. We cannot disturb that court's allowance of such costs unless we determine that it abused its discretion . See Syntex Opthalmics, Inc. v. Novicky, 795 F2d 983, 986, 230 USPQ 427, 430 (Fed. Cir. 1986). On the record before us, we discern no abuse of discretion.

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1414

JAMES CONSTANT, Appellant,

v.

ADVANCED MICRO-DEVICES, INC. et als.

Appellees

ORDER

A petition for rehearing having been filed in this case. UPON CONSIDERATION THEREOF, it is ORDERED that the petition for rehearing be, and the same hereby is, denied. The suggestion for rehearing in banc is under consideration.

FOR THE COURT

11/22/88

Francis X. Gindhart
Clerk

UNITED STATES COURT OF APPEALS

FOR THE FEDERAL CIRCUIT

88-1414

JAMES CONSTANT, Appellant

v.

ADVANCED MICRO-DEVICES, INC. et als.

Appellees.

ORDER

A suggestion for rehearing in banc having been filed in this case, UPON CONSIDERATION THEREOF, it is ORDERED that the suggestion for rehearing in banc be, and the same is declined.

FOR THE COURT

12/6/88

Francis X. Gindhart
Clerk

A P P E N D I X B

UNITED STATES DISTRICT COURT

FOR THE CENTRAL DISTRICT OF CALIFORNIA

CV 85 0262 SVW

JAMES CONSTANT,

Plaintiff,

v.

ADVANCED MICRO-DEVICES, INC., et al.,

Defendants

ORDER GRANTING DEFENDANT'S MOTION TO RETAX COSTS AND DENYING PLAINTIFF'S MOTION TO DISMISS AND DISALLOW COSTS AND FOR SANCTIONS

Defendant's motion to retax certain costs and plaintiff's motion to dismiss determination of costs, disallow costs and for sanctions against defendants came on for hearing before the United States District Court, Honorable Stephen V. Wilson presiding, on May 2, 1988 at 1:30 p.m., upon due notice. Defendant

Fujitsu Microelectronics, Inc. ("FMI") appeared through its counsel, Adrian M. Pruetz of Morrison & Foerster, and FMI represented the position of all defendants in this matter. Plaintiff James Constant appeared on his own behalf. The Court, having reviewed the memoranda, evidence and legal authorities filed in support of and in opposition to defendant's motion to retax certain costs and plaintiff's motion to dismiss and disallow costs and for sanctions, and having heard the arguments presented at the hearing;

IT IS HEREBY ORDERED:

1. Plaintiff's request that this Court recuse itself is DENIED.

2. Defendant's motion to retax the costs of the Special Master Robert Hillman and the costs of reproduction of specified documents against plaintiff is GRANTED, and plaintiff is ordered to pay defendant's

costs for those items in the amount of $95,289.71.

3. Plaintiff's motion to dismiss determination of costs, to disallow costs and for sanctions is DENIED, the costs taxed by the Clerk of the Court in the Bill of Costs are affirmed, and plaintiff is ordered to pay defendant's costs for those specified items in the amount of $28,542.29.

4. In accordance with the foregoing orders, costs in the total amount of $123,832.00 shall be entered into and made part of the Judgement entered in favor of defendants and against plaintiff on November 9, 1987, such costs to bear interest at the legal rate from date of entry, and such costs when recovered shall be payable to each defendant in the amount allowed.

DATED: May 10, 1988

STEPHEN V. WILSON

Honorable Stephen V. Wilson, United States District Judge

CERTIFICATE OF SERVICE

I certify that the foregoing PETITION FOR WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT was served on all parties on 14 February, 1989 by mailing first class a true and correct copy thereof to them addressed as follows:

Edwin Taylor
Blakely, Sokoloff, Taylor & Zafman
1245 Oakmead Parkway, Suite 101
Sunnyvale, CA 94086

Attorneys for
INTEL CORPORATION

Joseph Golant
Romney, Golant, Marten & Ashen
10920 Wilshire Boulevard, Suite 1000
Los Angeles, California 90024

Attorneys for GOULD, INC. and AMERICAN MICROSYSTEMS, INC.

Robert Schroeder
Pretty, Schroeder, Brueggemann & Clark
444 South Flower Street, Suite 2000
Los Angeles, CA 90071

Attorneys for ANALOG DEVICES, INC. and NEC

NEC ELECTRONICS, INC.

Richard Fybel
Morrison & Foerster
333 South Grand Avenue, 38th Floor
Los Angeles, California 90071

Attorneys for FUJITSU MICROELECTRONICS, INC.

Howard Brody
Grossmann, Graven, Perry & Block
523 West 6th Street, Suite 1130
Los Angeles, California 90014-1109

Attorneys for DIGITAL SWITCH, INC. and GRANGER ASSOCIATES, INC.

Martin Horn
Spensley, Horn, Jubas & Lubitz
1880 Century Park East, Suite 500
Los Angeles, California 90067

Attorneys for HITACHI AMERICA, LTD.

Kristin Cano
Curtis & Vaccaro
Manufacturers Bank Building
One Newport Place, Suite 700
Newport Beach, California 92660

Attorneys for Paradyne Corporation

Paul Malingagio
Sheppard, Mullin, Richter & Hampton
333 South Hope Street, 48th Floor
Los Angeles, California 90071

Attorneys for TEXAS INSTRUMENTS, INC.

Allen Katz
Munger, Tolles & Rickershauser
355 South Grand Ave., 35th fl
Los Angeles, CA 90071

Attorneys for ROCKWELL INTERNATIONAL CORPORATION and TRW, INC. Lead Counsel

Anthony de Alcuaz
Skjerven, Morrill, MacPherson, Franklin & Friel
25 Metro Drive, Suite 700
San Jose, California 95110

Attorneys for ADVANCED MICRO-DEVICES, INC.

Solicitor General
Department of Justice
Washington, D.C. 20530

14 February, 1989

James Constant
1603 Danbury Dr
Claremont, CA 91711
(714) 624-1801

pro se petitioner